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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,372	08/08/2001	Thomas I. Rogan	67,010-005; H2602-FN	2154

26096 7590 12/28/2006
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EXAMINER

BAYAT, BRADLEY B

ART UNIT PAPER NUMBER

3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	12/28/2006	PAPER

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/924,372
Filing Date: August 08, 2001
Appellant(s): ROGAN ET AL.

David J. Gaskey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 6, 2006 appealing from the Office action mailed January 4, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,015,167	SAVINO et al.	1-2000
2002/0116241 A1	SANDHU et al.	8-2002

Johnston, R. et al. "The Role of Electronic Commerce Technologies in Just-In-Time Replenishment" ISBN 0-8186-7862-3/97 (March 1997).

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-15, 17 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savino et al., (Savino, 6,015,167) in view of Sandhu et al., US 2002/0116241 A1 (hereinafter Sandhu).

As per claims 1, 6, 7, 10-15, 17 and 20-23, Savino discloses a method and system of electronically handling transactions, comprising the steps of: establishing a transaction identifier that is used during all stages of an order-to-cash trading cycle; electronically storing the transaction identifier such that the identifier is remotely accessible by a plurality of users; linking supplier information with the transaction identifier; linking purchaser information with the transaction identifier (columns 3-4, figures 1, 4, 5 and associated text. Although Savino discloses an embodiment wherein “a customer or supplier can easily access shipping and receiving status information pertaining to purchase orders and parts shipped (column 5, lines 18-21), it does not explicitly disclose updating status information indicating the status of the

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transaction during a corresponding phase of the transaction and linking the status information to the transaction identifier.

Sandhu, however, teaches a method in which a purchaser can monitor the updated status of each purchase order with suppliers to track various phases between the order and delivery process (§8-12, 16-32). Sandhu further teaches an interrelated modular method and system of creating, tracking, processing, monitoring, tracking and shipping orders between sellers and buyers used to update shipping orders, track inventories, forecast future purchase orders, update information regarding distribution of orders and access information to properly plan for utilizing the ordered product in an efficient and cost-effective manner (§30-32). Sandhu teaches the use of and ERP and EDI modular software mechanism to seamlessly and automatically integrate and link information with regards to the various phases of the purchase-order process between a buyer and supplier (§17-22). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine and utilize Sandhu's ERP system to coordinate shipping and receiving information by integrating, updating and tracking the status of various phases during a purchase order transaction to ensure accuracy and efficiency as per the objectives of Savino.

2. Savino further discloses the method of claim 1, including automatically providing at least selected portions of the information linked to the transaction identifier to a user (column 2, lines 21-35).

3. Savino further discloses the method of claim 1, including providing at least selected portions

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of the information linked to the transaction identifier to a user responsive to the user accessing the transaction identifier (column 2, lines 21-35; figure 3 and associated text).

8. Savino further discloses the system of claim 7, wherein the transaction identifier comprises a single bar code representing a number (figure 3, 5 and associated text).

9. Savino further discloses the system of claim 8, wherein the transaction identifier includes information identifying a customer, a purchase order number, shipment release number and packing slip number (column 4, lines 1-35, figure 3, 5 and associated text).

Claims 4, 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savino and Sandhu as applied to claim 1 above and in further view of “The Role of Electronic Commerce Technologies in Just-In-Time Replenishment” by Robert Johnston and Ruby Lee (hereinafter Johnston, ISBN 0-8186-7862-3/97) published in 1997.

As per claims 4, 5, 16, Savino discloses a method of electronically handling transactions, comprising the steps of: establishing a transaction identifier that is used during all stages of an order-to-cash trading cycle; electronically storing the transaction identifier such that the identifier is remotely accessible by a plurality of users; linking supplier information with the transaction identifier; linking purchaser information with the transaction identifier (columns 3-4, figures 1, 4, 5 and associated text. Although Savino discloses that an embodiment wherein “a customer or supplier can easily access shipping and receiving status information pertaining to

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purchase orders and parts shipped (column 5, lines 18-21), it does not explicitly disclose updating status information indicating the status of the transaction during a corresponding phase of the transaction and linking the status information to the transaction identifier.

Sandhu, however, teaches a method in which a purchaser can monitor the updated status of each purchase order with suppliers to track various phases between the order and delivery process (§16-32). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine and utilize Sandhu's ERP system to coordinate shipping and receiving information by integrating, updating and tracking the various phases during a purchase order transaction to ensure accuracy and efficiency as per the objectives of Savino.

Although Savino and Sandhu do not explicitly disclose a payment mechanism for their electronic commerce purchase and shipping process disclosed, Johnston teaches how automatically determining and facilitating payment from a customer to a supplier can be accomplished responsive to a selected portion of the transaction (§3-7.2). It would have been obvious for one of ordinary skill in the art at the time of the invention to automatically pay a supplier via an EFT, EDI or any electronic commerce payment system known in the art upon confirmation of receipt as taught by Sandhu in order to eliminate the accounts payable function and promote efficient, cost effective and timely coordination of the purchase order process from order to payment. In fact, Johnston's 1997 overview of electronic commerce order taking, production planning and payment process used by the automotive industry is strikingly similar to Savino and Sandhu's barcode generation and tracking process with the added feature of an automatic payment mechanism in order to eliminate the accounts payable function.

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Claims 18-19 are directed to a computer readable medium of the above claimed subject matter and is correspondingly rejected as above.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the Appellant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

(10) Response to Argument

Appellant erroneously contends, “there must be some motivation or suggestion from within the art to make a proposed combination (brief p. 14).”

In its recent decision, the Federal Circuit stated that “[a]lthough our predecessor court was the first to articulate the motivation-suggestion-teaching test a related test-the analogous art test-has long been part of the Graham analysis articulated by the Supreme Court.”¹ *In re Kahn*, No. 04-1616 (Fed. Cir. March 22, 2006). “The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection.”² *Id.* “References are selected as being reasonably pertinent to the problem based on

¹ See *Dann*, 425 U.S. at 227-29; *Graham*, 383 U.S. at 35.

² *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

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the judgment of a person having ordinary skill in the art.” Id. “[I]t is necessary to consider the reality of the circumstances – in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.”³ Id. “We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight.”⁴ Id.

Appellant further argues that there is no prima facie case for obviousness because “the proposed modification is directly contrary to the teachings of the base or primary reference (brief at 14). In support of this argument, Appellant cites portions of specific embodiments in Savino Id. at 14-15. In particular, Appellant contends that Savino teaches that information associated with a barcode “is only entered by the customer in order to ensure reliability of such information.” Id. The examiner respectfully disagrees.

As claimed by Appellant, Savino provides an invention to include a single identifier between buyers, sellers or other third parties in order to efficiently streamline and coordinate a transaction process. Savino’s reference as to purchase and shipping information refers to a customer’s entry of the purchase request and shipping address that would always be entered by the buyer or customer. Appellant quotes one sentence in the patented invention out of context and contends that the cited art teaches away from the claimed invention. See Savino Column 1, line 5 – column 2, line 35.

Sandhu et al. discloses the purpose of the invention as:

³ *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979).

⁴ *In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992).

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[0009] It is another object of the present invention to provide a method in which a buyer or purchaser can monitor the processing of purchase orders with third party logistics suppliers to enable buyers to efficiently and cost-effectively schedule personnel and equipment for use. This also allows buyers to modify purchase orders based upon the representations of third party logistics suppliers to ensure that appropriate amounts of the products that are the subject of the purchase orders are maintained at all times.

[0011] Buyers are allowed to monitor a seller's web server to receive **updates as to the status of buyer's purchase orders**. The seller's web server is in communication with the third party logistic supplier's website that is **updated regularly with information about the status of purchase orders**. Buyers can instantaneously receive information to properly schedule personnel and equipment for use of the product that is the subject of the purchase order, resulting in higher efficiency and cost savings. In addition, this monitoring allows buyers to modify purchase orders by increasing or decreasing the amount of product purchased as a function of their monitoring of the status of purchase orders (emphasis added).

“In many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspects of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other modification needed to arrive at the invention. A judgment must be made whether a person of ordinary skill in the art would have had sufficient motivation to combine the individual elements forming the claimed invention.” *In re Clinton*, 527 F.2d, 1226, 1228, 188 USPQ 365, 367 (C.C.P.A. 1976).

Accordingly, the cited references not only specifically point toward the modification needed to arrive at the invention, but also there is more than sufficient motivation for one of ordinary skill in the art to have combined the element of updating status information for forming the claimed invention.

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In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., information associated with the bar code is entered by others and not merely the customer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For instance, by pointing to a portion in Savino that does not reflect the scope and objective of the invention cannot show nonobviousness and does not teach away from the scope and object of Sandhu as purported by Appellant (brief p.16).

In response to Appellant's argument on page 16 of the brief that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., no updating of any status information regarding any portion of the order-to-cash trading cycle after the customer enters the information that results in generation of the barcode; a carrier providing updated information regarding shipping status) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Appellant does not substantively address the Johnston reference; therefore, the examiner relies on the rejection provided above. See brief at 16.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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